

REMARKS

This invention relates to heterocyclic acylsulfimides, to processes for their preparation and to their use as pesticides. Applicants discovered that the inventive compounds possess a good spectrum of activity against pests, e.g. arthropods or helminths while being well tolerated by mammals and aquatic animals, and plants.

The Examiner is thanked for indicating that claim.

It is believed that no fee is required for the consideration of this Amendment. However, if an additional fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

This Amendment makes minor changes to claims 30, 33, 34 and 35 and adds new claims 37 to 40. As the changes to claims 30, 33, 34 and 35 do not narrow the scope of the claim, the doctrine of equivalents is not affected. Support for the term "administering" is found, for example, in the third paragraph on page 36 or the paragraph bridging pages 36 and 37. Support for claims 37 to 40 is also found in these pages.

The rejection appears to make a restriction requirement between claims 30 to 36, alleging that these claims recite multiple utilities. Applicants respectfully disagree.

First, it should be noted that not all of these claims are method claims. Claims 34 to 36 are composition claims. Generally, it is Office policy to permit all of the composition claims that recite a novel compound issue in one application because the patentability of the composition claim generally resides with the patentability of the novel compound, the search of the compound claims and the composition claims overlap, and generally the U.S. Patent Office does not give much patentable weight to the intended utility in a composition claim.

With respect to the method claims, Applicants respectfully urge that the claims are all directed to one process and not to multiple processes as alleged in the rejection. The present invention provides for, *inter alia*, novel compounds that exhibit activity as pests such as arthropods and helminths (see p.1, lines 9 and 10). The location or site of the pests is immaterial to the method since the inventive compounds will kill arthropods and helminths regardless of whether the site is, for example, an animal, a plant, a seed or a piece of wood (see, e.g., p. 26, line 20 *et seq.*, p. 36, line 12, p. 38, line 11). As stated on page 38, line 16

[t]he use of the compounds according to the invention embraces, in addition to direct application onto the pests, any other application in which compounds of the formula (I) act on the pests. Such indirect applications can, for example, be the use of compounds which, for example in the soil, the plant or the pest, decompose into compounds of the formula (I) or are degraded into compounds of the formula (I).

Hence, Applicants urge that there is only one method being claimed; *viz.* killing of the respective pest.

Moreover, even if it were held that there are multiple methods present, it should be noted that MPEP §806.05(h) only satisfies one of the two criteria required for restriction between patentably distinct inventions. MPEP §803.01 indicates that in addition to the criteria that the inventions are patentably independent or distinct, in order for a restriction requirement to be proper, the requirement must establish that searching both inventions is a serious burden on the examiner. Given the fact that the compounds have been searched it is urged and that the compositions must be included with the search for the compounds since most if not all of the classes have been searched. Accordingly, reconsideration of this position is requested.

If, after consideration of this Amendment, the Examiner is of the opinion that the claims are not in condition for allowance, it is requested that he first telephone the undersigned before issuing another office action to see if a reasonable compromise may be reached.

Favorable action is earnestly solicited.

Respectfully submitted,

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